

### REMARKS

In response to the non-final Office Action of July 3, 2007, applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks. Claims 36-42, 44-50, 52-62, 64-66, and 68-97 are pending, with claims 36, 48, 56, 64, 68, 69, 82, and 85 being independent. Claims 77, 82, and 89 have been amended and claims 90-97 have been added. No new matter has been introduced.

#### **Interview Request**

Applicants respectfully request a personal interview with the Examiner prior to the substantive examination of this Reply. To that end, applicants' representative will be contacting the Examiner shortly to schedule an interview. However, to the extent that an interview has not been scheduled prior to the substantive examination of this Reply, applicants respectfully request the Examiner to treat the foregoing as a formal interview request and ask that the Examiner call the undersigned at (202) 783-5070 to schedule an interview prior to taking any further action in this case.

#### **Incomplete Office Action**

The Office Action contends that "[c]laims 82 and 85-87 do not define any new limitations above claims 36-38 and therefore are rejected for similar reasons." Non-final Office Action of July 3, 2007 at page 9, lines 6-7.

Applicants disagree and respectfully submit that claims 82 and 85-87 recite features that are not recited in claims 36-38 or in claims 39-42, 44-50, 52-62, 64-66, and 68-81. For example, none of claims 36-42, 44-50, 52-62, 64-66, and 68-81 recite receiving, from a sender, a request to establish a video communications session between the sender and a recipient that is concurrent with the presence-based communications session, as recited in independent claim 82. Furthermore, none of claims 36-42, 44-50, 52-62, 64-66, and 68-81 recite enabling display, to a sender, of an instant messaging graphical user interface that is configured to enable the sender to compose and send text instant messages to a recipient, determining if the recipient is capable of

participating in video instant messaging in response to initiating the text instant messaging session between the sender and the recipient, and enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging based on a determination that the recipient is capable of participating in video instant messaging, as recited in independent claim 85.

Moreover, although the Office Action summary indicates that claims 88 and 89 have been rejected, the Office Action does not articulate any grounds of rejection for claims 88 and 89, nor does the Office Action indicate which references the Examiner believes render claims 88 and 89 obvious.

Because the Office Action does not address all of the features recited in claims 82 and 85-87 and because the Office Action does not articulate any grounds of rejection for claims 88 and 89, applicants submit that the Office Action is incomplete, and, accordingly, the Examiner has failed to satisfy his burden of establishing that claims 82 and 85-89 are anticipated and/or rendered obvious by the prior art. Accordingly, due to the absence of a showing that claims 82 and 85-89 are anticipated and/or rendered obvious by the prior art, applicants request allowance of claims 82 and 85-89.

However, to the extent that the rejection of claims 82 and 85-89 is maintained, applicants request issuance of a new Office Action that clearly articulates the grounds of rejection for each of claims 82 and 85-89 and that shows how each feature of claims 82 and 85-89 is believed to be met by the prior art, so that applicants have a "fair opportunity to reply" to the rejection. See MPEP § 706.02(j). Furthermore, if/when such a new Office Action is issued, applicants submit that the new Office Action should be non-final as any grounds for rejection of claims 85-87 will be new grounds of rejection not necessitated by applicants' amendment of the claims. See MPEP § 706.06(a).

#### **Claim Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 36-38, 48-50, 56-58, 64-66, 68-82, and 85-87 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,212,548 (DeSimone) in view of U.S.

Patent No. 6,748,421 (Ozkan) and U.S. Patent No. 7,233,992 (Muldoon). Claims 39-42 and 59-62 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon in view of U.S. Patent No. 6,795,863 (Doty). Claims 44-47 and 52-55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon in view of U.S. Patent No. 6,529,475 (Wan). Claims 83 and 84 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon in view of U.S. Patent No. 6,223,213 (Cleron). Applicants request reconsideration and withdrawal of the rejection of claims 36-42, 44-50, 52-62, 64-66, and 68-89 because none of the applied references nor any proper combination of the applied references describes or suggests all of the features recited in independent claims 36, 48, 56, 64, 68, 69, 82, and 85.

Claims 36-42, 44-47, 56-62, 68, 70, 71, 74, 75, and 78-81

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify or combine reference teachings, there must be a reasonable expectation of success, and the proposed modification or combination of reference teachings must describe or suggest all of the features recited in the claim. See, e.g., MPEP § 2143.

Applicants submit that the Office Action fails to establish a prima facie case of obviousness with respect to claims 36-42, 44-47, 56-62, 68, 70, 71, 74, 75, and 78-81 at least because there is no suggestion or motivation to combine the teachings of DeSimone, Ozkan, and Muldoon in the manner proposed by the Office Action and, therefore, any proper combination of the teachings of DeSimone, Ozkan, and Muldoon does not describe or suggest all of the features recited in independent claims 36, 56, and 68. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 36-42, 44-47, 56-62, 68, 70, 71, 74, 75, and 78-81.

With respect to independent claims 36, 56, and 68, the Office Action acknowledges that DeSimone fails to describe or suggest storing a video instant message on behalf of a sender, receiving an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video

instant message to the recipient using the video communications session. See non-final Office Action of July 3, 2007 at page 3, line 21 to page 4, line 3. Therefore, the Office Action relies on Ozkan for teaching storing a video instant message on behalf of a sender and Muldoon for teaching receiving an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session. See non-final Office Action of July 3, 2007 at page 4, lines 4-13 and page 4, line 17 to page 5, line 4. The Office Action asserts that it would have been obvious to a person having ordinary skill in the art to modify the teachings of DeSimone in view of the teachings of Ozkan and Muldoon because doing so "allows for the completed video to be automatically sent without extra, unnecessary steps from the user" and because doing so "allows for the user to determine when to send the attachment." Non-final Office Action of July 3, 2007 at page 4, lines 11-13 and page 5, line 3-4.

Applicants disagree. As discussed more fully below, at the time of the invention, a person having ordinary skill in the art would not have been motivated to modify the teachings of DeSimone to store a video instant message on behalf of a sender, receive an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session, because what little disclosure there is in DeSimone of video communications appears to contemplate real-time videoconferencing sessions which do not involve sending completed videos. Thus, for at least the following reasons, no proper combination of DeSimone, Ozkan, and Muldoon describes or suggests storing a video instant message on behalf of a sender, receiving an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session, as recited in independent claims 36, 56, and 68.

DeSimone describes a system that enables a user to maintain multiple real-time chat sessions with a plurality of other participants using a single client application. See DeSimone at col. 2, lines 30-37. Although the participants in the various different chat sessions with the user may overlap, participants send messages in the context of particular chat sessions (i.e., conversations). See DeSimone at col. 2, lines 48-56. Therefore, DeSimone's system tracks the messages sent by the participants of the chat sessions in real-time in order to present the messages received from the participants of the chat sessions to the user in a manner that identifies the particular chat sessions to which they correspond. See DeSimone at col. 2, lines 48-56.

DeSimone briefly alludes to extending its disclosure to include video chat capabilities on two occasions. In particular, at column 1, lines 45-57, DeSimone states:

Extensions of the basic chat model of communications permit use of voice (or other audio), video and other message content.

DeSimone at col. 1, lines 45-47 (emphasis added). Similarly, at column 15, lines 58-63, DeSimone states:

though the preceding description has proceeded in terms of text messages, those skilled in the art will apply the present inventive teachings in communicating a variety of messages, including voice (or other audio), video (or other graphic) messages and in communicating mixed-mode messages or messages with a variety of attachments.

DeSimone at col. 15, lines 58-63 (emphasis added). Because DeSimone describes a system that enables a user to maintain multiple real-time chat sessions with a plurality of other participants using a single client application, extension of DeSimone's "inventive teachings" to include video chat capabilities would result in a system that enables a user to engage in multiple real-time video conferencing sessions with a plurality of other participants at one time.

Ozkan, meanwhile, describes a system for recording and sending a video in accordance with a user-defined video structure. See Ozkan at Abstract. More particularly, Ozkan describes a system that enables a user to create a hierarchical video structure for a video before recording the video. See Ozkan at col. 12, lines 20-29. Thereafter, while recording the video, the system

enables the user to label the starting and ending points of different sections of the video corresponding to the user-created video structure. See Ozkan at col. 12, lines 30-58. Upon completion of recording the video, the user can send the video to other users for viewing or the user can further edit the video. See Ozkan at col. 12, line 59 to col. 13, line 45. In the case where the video is sent to other viewers for viewing, the structured organization of the video allows the other users to identify and quickly navigate to the most salient sections of the video. Similarly, in the case where the user desires to further edit the video, the structured organization of the video enables the user to quickly navigate to the sections of the video most in need of editing.

Muldoon describes techniques for sending, receiving, and managing the exchange of confidential messages between an intranet and multiple external users using a secure server as an intermediary interface for Internet communications. See e.g., Muldoon at Abstract. In connection with describing how a secure server can be used to facilitate the sending, receiving, and exchange of confidential messages, Muldoon describes that an e-mail sender can add attachments to an e-mail and send the e-mail and its attachments to an intended recipient by pressing a "send button." See e.g., Muldoon at col. 8, lines 3-6 and 42-47. The implication of Muldoon's disclosure of adding attachments to an e-mail and sending the e-mail and its attachments to a recipient by pressing a "send button" is that the attachments, in whatever file format they might be, are completed before they are added to the e-mail and sent to the recipient.

The Office Action's position that a person having ordinary skill in the art would have been motivated to modify the teachings of DeSimone in view of the teachings of Ozkan and Muldoon to store a video instant message on behalf of a sender, receive an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session fails because, as discussed above, the natural extension of the "inventive teachings" of DeSimone to include video chat capabilities results in a system that enables a user to engage in multiple real-time videoconferencing sessions with a plurality of

other participants at one time and such real-time video conferencing sessions do not involve storing a video instant message on behalf of a sender, receiving an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session.

Rather, once a videoconference has been established, real-time video feeds of the other participants are available without requiring any additional user intervention. Therefore, absent any impermissible hindsight gleaned from review of the present application, at the time of the invention, there would have been no motivation to modify the teachings of DeSimone in view of the teachings of Ozkan and Muldoon to store a video instant message on behalf of a sender, receive an indication to trigger sending of the video instant message to a recipient after generation of the video instant message is complete, and, in response to receiving the indication to trigger sending of the video instant message to the recipient, initiating a transfer of the video instant message to the recipient using the video communications session.

Moreover, Muldoon's disclosure appears to be limited to techniques for sending, receiving, and managing the exchange of confidential messages via e-mail rather than via a presence-based communications application such as the real-time chat system described by DeSimone, and Ozkan's disclosure makes it clear that the system of Ozkan is not intended for use in conjunction with a presence-based communications application such as the real-time chat system described by DeSimone. For instance, Ozkan states:

typically[ video] communication is not simultaneously bi-directional, as opposed to the synchronous communication of person-to-person telephone calls or video conferencing.

Ozkan at col. 1, lines 26-29. Indeed, Ozkan acknowledges that presence-based communications such as face-to-face, telephone, and videoconference conversations are "a luxury put aside for relationship building and immediate closure . . . ." Ozkan at col. 1, lines 21-22. Therefore, rather than being intended for use in conjunction with a presence-based communications

platform, like that of DeSimone; Ozkan's system clearly is intended to enable a user to generate and send a video to a recipient who then may view the video at his or her convenience.

Thus, a person having ordinary skill in the art at the time of the invention would not have turned to the teachings of Ozkan and/or Muldoon, which contemplate non-real-time, non-presence-based delivery of messages, when considering a modification of DeSimone's teachings, which, in contrast, contemplate real-time, presence-based delivery of video. Therefore, applicants submit that the proposed combination is improper and, therefore, that none of DeSimone, Ozkan, Muldoon, or any proper combination thereof describes or suggests all of the features of independent claims 36, 56, and 68. Accordingly, for at least these reasons, applicants request reconsideration and withdrawal of the rejection of independent claims 36, 56, and 68 as well as their respective dependent claims, claims 37-42, 44-47 70, 71, and 78-81, claims 57-62, and claims 68, 74, and 75.

Claims 48-50, 52-55, 64-66, 69, 72, 73, 76, and 77

With respect to independent claims 48, 64, and 69, the Office Action acknowledges that DeSimone fails to describe or suggest receiving, on behalf of a recipient, a completed video instant message sent by a sender using a video communications session, and storing the video instant message on behalf of the recipient. Therefore, the Office Action applies Ozkan and Muldoon for teaching these features, asserting that it would have been obvious to a person having ordinary skill in the art to modify the teachings of DeSimone in view of the teachings of Ozkan and Muldoon because doing so "allows for the completed video to be automatically sent without extra, unnecessary steps from the user" and because doing so "allows for the user to determine when to send the attachment." non-final Office Action of July 3, 2007 at page 7, lines 3-4 and 10-11.

Applicants request reconsideration and withdrawal of the rejection of claims 48-50, 52-55, 64-66, 69, 72, 73, 76, and 77 because there is no suggestion or motivation to combine the teachings of DeSimone, Ozkan, and Muldoon in the manner proposed by the Office Action and,



therefore, any proper combination of the teachings of DeSimone, Ozkan, and Muldoon does not describe or suggest all of the features recited in independent claims 48, 64, and 69.

As discussed above, the natural extension of the "inventive teachings" of DeSimone to include video chat capabilities results in a system that enables a user to engage in multiple real-time videoconferencing sessions with a plurality of other participants at one time and such real-time video conferencing sessions do not involve the sending of completed video messages. Therefore, absent any impermissible hindsight gleaned from review of the present application, at the time of the invention, there would have been no motivation to modify the teachings of DeSimone in view of the teachings of Ozkan and Muldoon. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claims 48, 64, and 69 and their respective dependent claims, claims 49, 50, 52-55, 72, and 73, claims 65 and 66, and claims 69, 76, and 77.

Claims 82-84, 88, and 89

As amended, independent claim 82 recites a method that includes, among other features, establishing a video communications session between a sender and a recipient that is concurrent with a presence-based communications session between the sender and the recipient, and during the concurrent presence-based and video communications sessions between the sender and the recipient: generating a video instant message on behalf of the sender, receiving an instruction from the sender to send the video instant message to the recipient after generation of the video instant message is complete, initiating a transfer of the video instant message to the recipient using the video communications session in response to receiving the instruction to send the video instant message to the recipient, receiving a non-video message from the sender intended for the recipient, and initiating a transmission of the non-video message from the sender to the recipient using the presence-based communications session.

Applicants submit that independent claim 82 and its dependent claims, claims 83, 84, 88, and 89, are allowable at least because none of the references of record or any proper combination thereof describes or suggests establishing a video communications session between a sender and

a recipient that is concurrent with a presence-based communications session between the sender and the recipient, and during the concurrent presence-based and video communications sessions between the sender and the recipient: generating a video instant message on behalf of the sender, receiving an instruction from the sender to send the video instant message to the recipient after generation of the video instant message is complete, initiating a transfer of the video instant message to the recipient using the video communications session in response to receiving the instruction to send the video instant message to the recipient, receiving a non-video message from the sender intended for the recipient, and initiating a transmission of the non-video message from the sender to the recipient using the presence-based communications session, as recited in independent claim 82.

Moreover, as discussed above, applicants submit that the Office Action fails to satisfy its burden of establishing that claims 82-84, 88, and 89 are anticipated and/or rendered obvious by the prior art. Accordingly, for at least this additional reason, applicants request allowance of claims 82-84, 88, and 89. In the alternative, applicants request issuance of a new, non-final Office Action that clearly articulates the grounds of rejection for each of claims 82-84, 88, and 89 and that shows how each feature of claims 82-85, 88, and 89 is believed to be met by the prior art.

#### Claims 85-87

Independent claim 85 recites a method that includes, among other features, initiating an instant messaging session between a sender and a recipient, enabling display, to the sender, of an instant messaging graphical user interface associated with the initiated instant messaging session, determining if the recipient is capable of participating in video instant messaging, and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging.

Applicants submit that independent claim 85 and its dependent claims, claims 86 and 87, are allowable at least because none of the references of record or any proper combination thereof

describes or suggests determining if a recipient is capable of participating in video instant messaging, and, based on a determination that the recipient is capable of participating in video instant messaging, enabling the graphical user interface associated with the instant messaging session to reflect that the recipient is capable of participating in video instant messaging, as recited in independent claim 85.

Moreover, as discussed above, applicants submit that the Office Action fails to satisfy its burden of establishing that claims 85-87 are anticipated and/or rendered obvious by the prior art. Accordingly, for at least this additional reason, applicants request allowance of claims 85-87. In the alternative, applicants request issuance of a new, non-final Office Action that clearly articulates the grounds of rejection for each of claims 85-87 and that shows how each feature of claims 85-87 is believed to be met by the prior art.

#### **New Claims**

Each of new claims 90-97 depends from one of independent claims 36, 48, 56, 64, 68, 69, 82, and 85. Accordingly, applicants submit that new claims 90-97 are allowable at least because of their dependencies and for the reasons discussed above in connection with independent claims 36, 48, 56, 64, 68, 69, 82 and 85.

#### **Conclusion**

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant : Noel Enete et al.  
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The fee in the amount of \$520 in payment of the Excess Claims fee (\$400) and the Petition for One-month Extension of Time (\$120) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

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Andrew T. Foy  
Reg. No. 57,333

Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (202) 783-2331

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